

REMARKS/ARGUMENTS

Favorable reconsideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Claims 1-21 are pending in the present application, Claims 1, 8, 12, 14, 19, and 20 having been amended. Support for the amendments to Claims 1, 8, 12, 14, 19, and 20 is found, for example, in Applicants' Figs. 7 and 8C (model ID), and on page 26, lines 11-19, in the specification. Applicants respectfully submit that no new matter is added.

In the outstanding Office Action, Claims 1-21 were rejected under 35 U.S.C. § 103(a) as unpatentable over Paradinas et al. (U.S. Patent Publication No. 2002/0116478, hereinafter Paradinas) in view of Shields et al. (U.S. Patent Publication No. 2003/0225797, hereinafter Shields).

With respect to the rejection of Claim 1, Applicants respectfully submit that the amendment to Claim 1 overcomes this ground of rejection. Claim 1 recites,

A file creation method which creates a program-addition file for adding a program to a program-initiation recording medium of an information processing apparatus, comprising the steps of:

acquiring identification information of the program-initiation recording medium and model identification of the information processing apparatus in response to a program adding request received from a computer terminal connected to the information processing apparatus via a network; and

creating a program-addition file in response to the identification information and the model identification so that starting of the program on the information processing apparatus is allowed by the program-addition file with the program stored in the program-initiation recording medium.

Paradinas and Shields, taken alone or in proper combination, do not disclose or suggest every element of amended Claim 1.

The outstanding Office Action acknowledges that Paradinas does not explicitly indicate “and model information of the information processing apparatus” nor “and the model identification.” The outstanding Office Action takes the position that Shields discloses “and model information of the information processing apparatus” and “and the model identification.”

The asserted combination of Paradinas and Shields does not disclose or suggest all of the features of amended Claim 1. Paradinas does not disclose or suggest the claimed “acquiring identification information of the program-initiation recording medium and model identification of the information processing apparatus” and “creating a program-addition file in response to the identification information and the model identification”. Paradinas does not disclose or suggest that the application description stored on the smart card of Paradinas includes model identification information of the information processing apparatus.

The Office Action takes the position that the “acquiring” step and “creating” step of independent Claim 1 are described in [0047] of Shields. However, Shields discloses in Figure 5 the processing performed by the client mail application 322 on the mobile device 320 and the processing performed by the synchronization application 312 on the server 310. The synchronization application 312 is configured to filter the files before downloading to the mobile device. Paragraph [0047] of Shields merely describes that the device type column 603 of a profile 600 identifies a model number for the mobile device as shown in Figure 6 of Shields. The synchronization application 312 at block 536 identifies a device type associated with the mobile device 320, and at block 538 reads a profile 600 associated with the device type (identified at the block 536).

There is no disclosure or suggestion in Shields that the synchronization application 312 on the server 310 acquires identification information of the program-initiation recording medium and model identification of the information processing apparatus in response to a

program adding request received from a computer terminal connected to the information processing apparatus via a network, as recited in the amended Claim 1.

Moreover, there is no disclosure or suggestion in Shields that the synchronization application 312 on the server 310 creates a program-addition file in response to the identification information and the model identification so that starting of the program on the information processing apparatus is allowed by the program-addition file with the program stored in the program-initiation recording medium, as recited in the amended Claim 1.

Shields merely provides an isolated example of model identification that is unrelated to the context in which model identification is used in the invention of Claim 1. There is no disclose or suggestion in Shields to acquire model identification in response to a program adding request, nor is their a disclosure or suggestion to “[create] a program-addition file in response to the identification information and the model identification so that starting of the program on the information processing apparatus is allowed by the program-addition file with the program stored in the program-initiation recording medium.” The “and model identification of the information processing apparatus” and “and the model identification” cannot be view in the abstract when making an obviousness determination. As required by 35 U.S.C. §103(a), a proper analysis must consider “the subject matter as a whole.” Thus, it is improper to divorce the claimed “and model identification of the information processing apparatus” and “and the model identification” from the context of the whole invention defined by Claim 1.

The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co. v. Teleflex Inc. (KSR)*, 550 U.S. ___, 82 USPQ2d 1385 (2007) noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Court quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006) stated

that "[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. It is this required "supporting analysis" that is missing relative to the outstanding rejections.

In this regard, the outstanding rejection applied to Claim 1 mischaracterizes Claim 1 by breaking the invention down into its components, and not considering the invention as a whole. Accordingly, the outstanding Office Action lacks the required "supporting analysis."

The relied upon teaching of paragraph [0047] of Shields relates to a profile that includes a model number of a mobile device, but does not mention that the model number is acquired in response to program adding request as described in amended Claim 1, and does not indicate that a file is created in response to the model number as described in amended Claim 1.

Accordingly, the asserted combination of Paradinas and Shields does not teach or suggest all of the features of amended Claim 1.

In view of the above discussion, Applicants respectfully submit that Claim 1 (and claims dependent thereon) patentably distinguish over Paradinas in view of Shields. Claims 8, 12, 14, 19, and 20 recite elements similar to those of amended Claim 1. Accordingly, Claims 8, 12, 14, 19, and 20 patentably distinguish over Paradinas in view of Shields, for at least the reasons stated for Claim 1.

Applicants respectfully traverse the rejection of Claim 16. Again, the proper analysis under 35 U.S.C. §103(a) is missing. Paradinas and Shields, taken in proper combination, do not disclose or suggest the claimed "a program addition unit performing an authentication check of the program-addition file read from the program-addition medium based on model identification of the information processing apparatus." Again, the Office errs by only considering the "model identification" in isolation, and not in the context of the invention as a

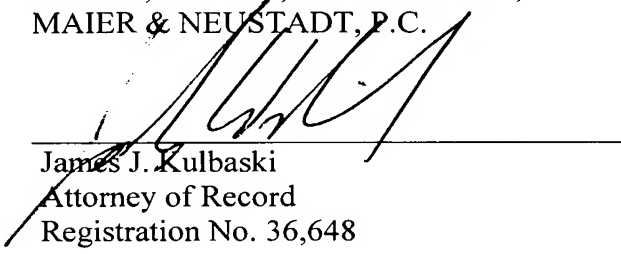
whole as required by 35 U.S.C .§103(a). The description of a model number in Shields being located in a profile does not disclose or suggest performing an authentication check based on model identification.

Accordingly, Shields does not cure the deficiency in Paradinas, and Claim 16 (and claims dependent thereon) patentably distinguish over Paradinas and Shields, taken alone or in proper combination.

Consequently, in light of the above discussion and in view of the present amendment, the present application is believed to be in condition for allowance and an early and favorable action to that effect is respectfully requested.

Respectfully submitted,

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